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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NATASHA P. HIXON and MARK A. HIXON

Appeal 2009-003090
Application 10/718,852
Technology Center 3700

Before: WILLIAM F. PATE III, STEFAN STAICOVICI, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 48 and 61-77. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

The claims are directed to a die for use in a die cutting system. Spec. 2, para. [0002]. Claim 48, reproduced below, is illustrative of the claimed subject matter:

48. A die for forming patterns from a sheet of material, comprising:

a portable, substantially rigid, substantially planar plate;
at least one cutting edge protruding from a surface of said substantially planar plate.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Gaspari	US 3,469,488	Sep. 30, 1969
Ehlscheid	US 4,537,588	Aug. 27, 1985
Sabin	US 5,172,622	Dec. 22, 1992

REJECTIONS

Claims 64-68 and 70 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Ans. 3.

Claims 48, 61, 62, 68, 75 and 77 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gaspari. Ans. 3.

Claims 48, 61-67, and 77 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sabin. Ans. 4.

Claims 48, 61, 62, 68-70, 75, and 76 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ehlscheid. Ans. 4.

Claims 71-74 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaspari and Ehlscheid. Ans. 4.

OPINION

Turning first to the rejections under 35 U.S.C. § 112, second paragraph, and considering the rejection of claim 64, we will not sustain this rejection. We agree with Appellants that this claim which contains the term “a support” is referring to a different support from the substantially rigid support found in claim 63. Therefore, this claim is not indefinite within the purview of 35 U.S.C. 112, second paragraph.

With respect to claims 65-68 and 70, Appellants admit that these claims contain errors (App. Br. 6-7), and the rejection of these claims under 35 U.S.C. § 112, second paragraph, is affirmed.

Turning to the rejections under 35 U.S.C. §§ 102 and 103, we find that we must construe the claim term “substantially planar” as it is found in independent claims 48 and 62. Appellants argue that the term “substantially planar” is intended to signify that the plate portion of each die is very thin. The Examiner has construed the term with an ordinary and customary meaning of flat or lying in a single plane. Ans. 6.

We find little support for Appellants’ proffered definition. While we acknowledge that Appellants can act as their own lexicographer, Appellants’ Specification does not provide support for Appellants’ proffered definition. For example, the initial line of paragraph [0004] defines a die as a “thin planar plate.” In paragraphs [0015] and [0030] the die is defined as a thin, substantially planar plate 62. The use of the word “thin” and the term

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“substantially planar” in the same description conveys the meaning that these terms are not synonymous but are different descriptors of the claimed die. Furthermore, the description of the die surface 22 as “substantially planar” conveys that the surface, which by definition has no depth, is flat. *See Spec. para. [0041].* Accordingly, the Examiner’s construction of the claim term “substantially planar” as “of or relating to a plane or flat” is an ordinary and customary meaning of the claim term in full consonance with Appellants’ Specification and is the construction we will use in this decision.

Turning to the 35 U.S.C. § 102 rejection as anticipated by Gaspari, we adopt the Examiner’s factual findings as our own. *See Ans. 3.* We note Appellants’ argument based on the thickness of Gaspari that the disclosed die is not substantially planar. As noted above, this argument is based on a faulty claim construction by Appellants. While Gaspari is somewhat thicker than Appellants’ disclosed die, a “relatively thin die” has not been claimed. Accordingly, it is our finding that claims 48, 61, 62, 75, and 77 are anticipated by Gaspari. However, we do not find claim 68 to be anticipated by the reference, inasmuch as the cutting-edge does not protrude from the plate a greater distance than the thickness of the plate. Therefore, the rejection of claim 68 as anticipated by Gaspari is not sustained.

With respect to the rejection of claims 48, 61-67, and 77 as anticipated by Sabin, we adopt the Examiner’s factual findings as our own. *See Ans. 4.* Appellants’ sole argument again appears to be directed to the thickness of the plate. For the reasons given in our discussion regarding claim construction *supra*, this argument is not credited. Accordingly, the rejection of claims 48, 61-67, and 77 as being anticipated by Sabin is affirmed.

With respect to the rejection of claims 48, 61, 62, 68-70, and 75-76 as anticipated by Ehlscheid, we adopt the Examiner’s findings as our own. *See*

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Ans. 4. In the Reply Brief, Appellants argue that Ehlscheid is limited to dies that are curved. Reply Br. 3:14. We note that the die of Ehlscheid is formed by etching and exists before the die is curved and the opposite edges are formed. Ehlscheid, col. 3, ll. 19-44. It has long been held that an intermediate product or article can anticipate a claimed article even if the intermediate product is merely a stage in the final production of the non-anticipatory article. *See In re Mullin*, 481 F.2d 1333, 1335-36 (CCPA 1973) (an article that is intended and appreciated is no less anticipatory be it an intermediate structure rather than an end use item). Accordingly, Appellants' argument that Ehlscheid is curved with bent retention features is not persuasive. Appellants further argue that the die of Ehlscheid is not rigid since it is relatively thin. While we agree that the backing plate of the die is etched to a thickness of only 0.2 mm, (Ehlscheid, col. 1, ll. 41) we do not believe that the stated thinness is dispositive of a die that is not rigid. Ehlscheid states in several locations that the die is bent, which connotes to us a die of relatively rigid construction. *See* col. 2, ll. 67; col. 3, ll. 38. Finally, the claim does not preclude the die cutting-edge from being razor-sharp. Accordingly, we affirm the rejection of claim 48 as lacking novelty.

We do not affirm the 35 U.S.C. § 102 rejection of claims 61, 62, 68-70, 75, and 76 as being anticipated by Ehlscheid, inasmuch as Appellants argue that Ehlscheid does not disclose a die supported by a substantially planar die supporting surface. The support surface disclosed in the reference is curved.

It is noted that Appellants argue that neither Sabin nor Ehlscheid are for use in a portable press. First, we believe that Sabin discloses a portable press. Second, this limitation is in the nature of an intended use and cannot

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limit the subject matter of the claim which is directed to a mere die that would find utility in all manner of presses.

Turning to the rejection of claims 71-74 under 35 U.S.C. § 103 as unpatentable over Gaspari or Ehlscheid, we conclude that these claims are *prima facie* obvious over the reference to Gaspari. We agree with the Examiner that the exact size of the die would have been a matter of choice to one of ordinary skill in the art. We further note that we regard Gaspari as a portable die cutting apparatus, inasmuch as “portable” has not been otherwise defined in the claims and the apparatus of Gaspari looks to be of the size that could be carried by an individual. We do not affirm the obviousness rejection based on Ehlscheid, inasmuch as Ehlscheid does not disclose a substantially planar supporting surface as required by the independent claim 62.

As noted above, we have found the subject matter of the claims 71-74 on appeal to be *prima facie* obvious. Whenever obviousness is found with respect to the subject matter on appeal, and Appellants furnish evidence of secondary considerations, it is our duty to reconsider the issue of obviousness anew, carefully weighing the evidence for obviousness with respect to the evidence against obviousness. *See, e.g., In re Eli Lily & Co.*, 902 F.2d 943, 945 (Fed. Cir. 1990). We are also mindful that the objective evidence of nonobviousness in any given case may be entitled to more or less weight depending on its nature and its relationship with the merits of the invention. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983). To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore we must determine whether there is a nexus between the merits of the claimed

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invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42 (Fed. Cir. 1985).

We further note that to the extent that the claims have been found unpatentable under § 102 of the statute, Appellants' evidence of secondary considerations is unavailing. Evidence of secondary considerations is inapplicable to rejections under 35 U.S.C. § 102. *See In re Wiggins*, 488 F.2d 538, 543 (CCPA 1973) ("evidence of commercial success, no matter how striking, could not overcome a rejection of a claim based on its lack of novelty. It is simply not relevant or material to that point."). "[S]econdary considerations are not an element of a claim of anticipation." *Cohesive Techs. Inc. v. Water Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008).

In paragraphs 4-14 of his Declaration, Mr. Ruff states the sales figures for the QuicKutz die cutting system. While we acknowledge that the gross sales figures for kits containing the dies has increased year-to-year, without more, this is not evidence probative of commercial success.

Evidence of number of units sold, volumes of dollar sales, or proof of existing market share, quite simply does not indicate anything with regard to the reasons for commercial success. *See, e.g., Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026 (Fed. Cir. 1985) (number of units sold and profit per unit not enough); or *Vandenberg v. Dairy Equip. Co.*, 740 F.2d 1560, 1567 (Fed. Cir. 1984) (evidence of dollar sales alone insufficient); or *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1151 (Fed. Cir. 1983) (number of units sold not enough). Such evidence must be placed in perspective by demonstrating that the subject invention displaces prior art devices or surpasses the volumes sales of prior art devices. *See Vandenburg v. Dairy Equip.*, 740 F.2d at 1567.

In paragraphs 15-19 of his Declaration, Mr. Ruff provides evidence alleged to establish long felt need. Paragraph 15 appears to contain testimonial quotes from magazines. While generally laudatory, these quotes do not establish long felt need. Likewise, paragraphs 16-19 state that competitors are copying Appellants' die. Mere copying alone is insufficient to establish long felt need.

Establishing long-felt need requires objective evidence that an art-recognized problem existed in the art for a long period of time without solution. In particular, the evidence must show that the need was a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 538 (CCPA 1967). The relevance of long-felt need and the failure of others to the issue of obviousness depend on several factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1383 (Fed. Cir. 1983); *see also In re Gershon*, 372 F.2d at 538. Second, the long-felt need must not have been satisfied by another before the invention by applicant. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988) (“[O]nce another supplied the key element, there was no long-felt need or, indeed, a problem to be solved.”) Third, the invention must in fact satisfy the long-felt need. *In re Cavanagh*, 436 F.2d 491, 496 (CCPA 1971). “[L]ong-felt need is analyzed as of the date of an articulated identified problem and evidence of efforts to solve that problem.” *Texas Instruments, Inc. v. Int'l Trade Comm'n*, 988 F.2d 1165, 1178 (Fed. Cir. 1993).

Based on the above analysis, Appellants' evidence from Mr. Ruff's Declaration cannot be accorded great weight. Balancing all the

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evidence anew, it is our conclusion that the evidence for obviousness outweighs the evidence against obviousness.

DECISION

The rejection of claim 64 under 35 U.S.C. § 112, second paragraph, is reversed.

The rejection of claims 65-68, and 70 under 35 U.S.C. § 112, second paragraph, is affirmed.

The rejection of claims 48, 61, 62, 75 and 77 as anticipated by Gaspari is affirmed.

The rejection of claim 68 as anticipated by Gaspari is reversed.

The rejection of claims 48, 61-67 and 77 as anticipated by Sabine is affirmed.

The rejection of 48 as anticipated by Ehlscheid is affirmed.

The rejection of 61, 62, 68-70, 75 and 76 as anticipated by Ehlscheid is reversed.

The rejection of claims 71-74 as unpatentable over Gaspari or Ehlscheid is affirmed, inasmuch as we have determined these claims are unpatentable over Gaspari.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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